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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/328,910

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YUJIRO KAJIHARA

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05/14/2009

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EXAMINER

CLARK, JASMINE JHIHAN B

ART UNIT

PAPER NUMBER

2815

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/328,910	Applicant(s) KAJIHARA ET AL.	
	Examiner Jasmine J. Clark	Art Unit 2815	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 October 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 and 50-76 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 and 50-76 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>2/21/7, 10/9/8</u> . | 6) <input type="checkbox"/> Other: _____ |

Reissue Applications

1. The reissue oath/declaration filed with this application is defective because it fails to identify at least one error which is relied upon to support the reissue application. See 37 CFR 1.175(a)(1) and MPEP § 1414.

Claims 63 and 68 were amended and new claims 73-76 added. The error being corrected in the Oath of 2/15/2000 is no longer applicable to the reissue.

The error refers to added claims 15-36, directed to a method of manufacturing, whereas claims 15-36 have been cancelled. There are no method claims being examined.

Claims 1-14, and 50-76 are rejected as being based upon a defective reissue application under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175.

The nature of the defect(s) in the reissue application is set forth in the discussion above in this Office action.

Claim Rejections - 35 USC § 112

2. Claims 1-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 is indefinite because the invention of claim 1 is not particularly pointed out and distinctly claimed. Claim 1 presents one coverage in divisional reissue application and another in the present reissue application. This is inconsistent.

The reissue application should then be advised to follow a procedure similar to the following example:

If there are patent claims 1-10 in two divisional reissue application and an applicant wishes to revise claim 1, which is directed to AB (for example) to ABC in one divisional reissue application, and ABD in a second divisional reissue application, applicant should do the following: Claim 1 in the first divisional reissue application can be revised to recite ABC. Claim 1 in the second divisional reissue application would be canceled, and new claim 11 would be added to recite ABD. The physical cancellation of claim 1 in the second divisional reissue application will not prejudice applicant's rights in the amended version of claim 1 *>because< those rights are retained via the first reissue application. Claim 1 continues to exist in the first reissue application, and both the first and second reissue application taken together make up the totally of the correction of the original patent.

Double Patenting

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

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3. Claims 1-14 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-14 of copending Application No. 09/989242. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented. The amendments made in the reissue 09/989242 do not render the claims patentably distinct. (See MPEP 1451).

4. Claims 50-76 are rejected under 35 U.S.C. as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Pannu v. Storz Instruments Inc.*, 258 F.3d 1366, 59 USPQ2d 1597 (Fed. Cir. 2001); *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to claim subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope of claim subject matter surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application. See MPEP 1412.02.

Applicant may rebut a recapture rejection by demonstrating that a claim rejected for recapture includes one or more claim limitations that “materially

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narrow” the reissue claims. The claims do not “materially narrow” one or more “overlooked aspects” of the invention.

During the prosecution of the patent under reissue, the claims 25 and 27 were amended to overcome art such that bonding wires “is positioned under a substantially central portion of said semiconductor chip, wherein”, by adhesive, and “wherein said semiconductor chip is fixed to a part of each of said suspension leads by adhesive which is located under a peripheral portion of said semiconductor chip,” and argued.

Claim 49 had “positioned under a substantially central portion” and “by adhesive” added and argued, and “and wherein said semiconductor chip is fixed to a part of each of said suspension leads by adhesive which is located under a peripheral portion of said semiconductor chip” added and argued.

Claims 25 and 29 had “an adhesive region of said chip mounting portion and said semiconductor chip and an adhesive region of each of said suspension leads and said semiconductor chip are separated from each other”.

Claims 25, 29, 43, 53 and 54 had added: “wherein said suspension leads and said chip mounting portion of said lead frame or continuously formed in an area of said semiconductor chip” and argued.

The reissue claims rejected under recapture remove part or all of one or more of the amendment made during the prosecutions listed above. According to MPEP section 1412.02, broadening a claim limitation amended during prosecution to overcome art is recapture, and should be rejected accordingly. Therefore, the removal of these limitations constitutes recapture.

Telephone Inquiry Contacts

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jasmine J. Clark whose telephone number is (571) 272-1726. The examiner can normally be reached on Flex.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's SPRE, Jose Dees can be reached on (571) 272-1659. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JC/05/11/2009

/Jasmine J Clark/
Primary Examiner, Art Unit 2815